

### REMARKS/ARGUMENTS

Rejection of claims 19, 20 and 22-26 under 35 U.S.C. 103(a) as being unpatentable over the cited patents is respectfully traversed. The Examiner has literally repeated the grounds of rejection raised in the prior Office letter, and has responded to applicant's arguments by stating that "one having ordinary skill in the art at the time of the invention would find it obvious that this area (Toyama's handle 55, Fig. 3) **could** (emphasis by applicant) represent a receiving recess for an information sheet."

In order to avoid redundancy and since the Examiner's grounds of rejection were merely repeated, applicant incorporates the previous response herein, rather than to repeat it. However, it is emphasized that the only reference to feature 55 in Toyama is found in col. 7, line 14, where it is stated that "55 designates a handle." No recess is described, nor is there any hint for the utility of such a recess in Toyama's hand stamp. The line design on top of handle 55 has not been described and it is certainly **not** shown as a **recess** for accommodating an information sheet. Even farther removed from the illustration of Toyama's handle 55 is a recess extending continually from the top side to at least one of the broad sides and delimited by edges before it reaches

the narrow sides, as claimed, and illustrated handle 55 most certainly does not even hint the cover recited at (d) of claim 19, snapping into the claimed recess in the claimed manner.

As to the Examiner's assertion that a person of ordinary skill **could** have reached the conclusion that handle 55 represents a recess for an information sheet, applicant respectfully submits that this does not meet the standard of obviousness of Sec. 103. As the Court of Appeals, Federal Circuit, pointed out in **Orthokinetics Inc. v. Safety Travel Chairs Inc.**, 1 USPQ2d 1081, at 1087,

"...the district court's analysis employed an inappropriate 'would have been able to produce' test. The statute, Sec, 103, requires much more, i.e., that it would have been **obvious** to produce the claimed invention at the time it was made without the benefit of hindsight (emphasis by Court)."

While, as the Examiner has argued, a person of ordinary skill in the art may have been able to produce the claimed recess and cover, this certainly was **not obvious** from the illustration of handle 55, without any further description or indication of what the lines on top of the handle indicate. Applicant has submitted evidence that they most likely are meant to suggest a **design** on top of the handle, as shown in the sales literature of record.

The fact is that applicant faced a problem and its solution, which is never even considered by Toyama. Citing a long line of appellate decisions, the Court of Appeals, Federal Circuit, held in **Diversitech Corp. v. Century Steps Inc.**, 7 USPQ 1315, at 1318,

"The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve that problem."

Applicant respectfully submits that the Examiner's description of the Wall et al, Toyama and Hoshino patents, as applied to features (c)(3), (d) and (d)(1), does not address the problem faced and solved by applicant and that, therefore, these patents do not make these feature obvious. Using "the benefit of hindsight" rejected by **Orthokinetics**, cited, and without a basis in the actual disclosures in the prior art, the Examiner reached the conclusion that it **could** make the claimed invention obvious.

Specifically, for example, the literature submitted by applicant and of record herein shows that it has been quite common (and, therefore, requires no description by Toyama) to use handles with differently colored plastic parts on top of the handle. This makes particular sense because Toyama uses a cylindrical stamp member 51, which must be rolled over the

paper to be stamped and pressed down, so that handle 55 must be firmly gripped. As shown by the sales literature of record, this can be accomplished by the use of a different plastic part on top of the handle, which provides better friction and a stronger grip than the plastic used for the remainder of the handle.

Had Toyama had a recess for an information sheet in mind, this would have been a significantly enough feature to be described while, as the sales literature showing the state of this particular art feature shows, no description is needed for a hand stamp handle comprised of different materials on top.

As recited in claim 19, transparent cover 24 is snapped into recess 17 holding information sheet 18, and it comprises inwardly extending locking projections 25, 25a, 25b for snapping into locking recesses 26, 26a, 26b in the receiving recess on the broad sides of actuating frame 8. This structure differs considerably from Shih's cover 34 since applicant's cover extends to the broad side of the actuating frame (handle). This has the advantage that the curved cover of applicant is securely held over the recess with relatively few fixing means.

Advantageously, as shown in Fig. 3, the assembly of applicant's device is very simple: information sheet 18 (see broken line) may initially be laid into the inside of curved transparent cover 24, where it is held in position under its own tension by locking projections 25, without any danger of becoming mispositioned. The cover with the information sheet is then simply snapped into receiving recess 17. As also seen in Fig. 4, the information sheet thereupon comes to lie on the top surface of receiving recess 17, its lower edges are displaced away from projections 25 and come to rest on the projections defining locking recesses 26. Such a surprisingly simple and securely fixed positioning of information sheet 18 would not be possible in the Shih device because his receiving recess is not L- or U-shaped in cross section, i.e. it does **not** extend continually from the top side to at least one of the broad sides. In the Shi device, where label 35 is received in recess 31 before cover 34 is mounted thereover, the label is likely to be mispositioned in the recess unless its dimensions are **exactly** the same as the recess. Such accurate dimensioning would require additional manufacturing costs.

As to Wall et al, they provide a two-part operating member 4 comprised of hollow encase 4a and closure 4b, the closure being snapped into the encasement at 55. Snap connections are, of course, well known but it is respectfully submitted that Wall et al do not make it obvious to provide the claimed snap

connection of applicant's transparent cover over an information sheet in the claimed recess, a combination far removed from Wall et al's two-part operating member and solving a problem not suggested by Wall et al.

In view of the above, it is respectfully submitted that amended claim 19 is clearly patentable over the art. Since the dependent claims define further features of the receiving recess and/or the transparent cover, neither of which is suggested by the prior art in the combination of the claimed self-inking hand stamp, these claims are believed to be allowable on their own merits.

A sincere effort having been made to overcome all grounds of rejection, favorable reconsideration and allowance of claims 19, 20 and 22-26 are respectfully solicited.

A request for a one-month extension is attached.

Respectfully submitted,  
Ernst FABER



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